

Notice of Allowability

Application No.

10/687,929

Examiner

Janis L. Dote

Applicant(s)

YAMAZAKI ET AL.

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Jul. 31, 2006.
2. ☒ The allowed claim(s) is/are 1 and 29.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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1. The examiner acknowledges the cancellation of claims 2-28 and 30-35 and the amendments to claims 1 and 29 set forth in the amendment filed on Jul. 31, 2006. Claims 1 and 29 are pending.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance:

The rejections of claims 12, 18-21, and 32 under 35 U.S.C. 103(a) over WO 02/084408 A1 (Matsumura) combined with other cited prior art, set forth in the office action mailed on Mar. 31, 2006, paragraphs 7 and 8, have been mooted by the cancellation of claims 12, 18-21, and 32 set forth in the amendment filed on Jul. 31, 2006.

The rejections under 35 U.S.C. 103(a) of claims 1-10, 12, 14, 18, 20-28, and 30-35 over US 4,795,689 (Matsubara'689), as evidenced by US 4,940,644 (Matsubara'644), combined with the other cited prior art, set forth in the office action mailed on Mar. 31, 2006, paragraphs 10-17, have been withdrawn in response to the amendment to claim 1 filed on Jul. 31, 2006. The amendment to claim 1 adds the limitation of now-canceled claim 16 that "the weight average molecular weight Mw of the amorphous polyester is in the range of 5×10^3 to 4×10^4 ." As discussed in paragraphs 10 and 11, Matsubara'689 exemplifies

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toners comprising a binder resin that comprises a block polyester resin, a crystalline polyester resin, and a nonlinear polyester resin. Toners 3 and 6 in Table 4; and nonlinear polyester A-3 in Table 1. Matsubara'689 does not disclose the weight average molecular weight of non-linear polyester resin A-3. Moreover, Matsubara'689 teaches that it is desirable that the nonlinear polyester resin has a weight average molecular weight of "not less than 50,000," which is outside the weight average molecular weight range of 5×10^3 to 4×10^4 recited in instant claim 1. According to Matsubara'689, "[i]f the weight average molecular weight Mw is extremely small, the antioffset property can be lowered." Col. 5, lines 6-9. Thus, it appears that Matsubara'689 teaches away from the amorphous polyester resin having the weight-average molecular weight recited in instant claim 1. In addition, neither Matsubara'689 nor the other cited prior art teaches or suggests a toner comprising an external additive where "the ratio of the external additive liberated from the surface of toner particles of the toner is 5 wt% or less" and where at least a part of the liberated external additive "functions as a micro carrier to be charged with polarity opposite to that of the toner particles" as recited in instant claim 29.

The rejections under the judicially created doctrine of

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obviousness-type double patenting of claims 1-6, 8-15, 17-28, 30-32, 34, and 35 over claims 3, 6-10, 20, and 22-26 of copending Application No. 10/474,753 (Application'753) in view of the other cited references, set forth in the office action mailed on Mar. 31, 2006, paragraphs 20-26, have been withdrawn in response to the amendment to claim 1 filed on Jul. 31, 2006, described supra. The claims of Application'753 do not recite nor do the other cited references disclose or suggest the amorphous polyester having the particular weight average molecular weight recited in instant claim 1. In addition, the claims in Application'753 do not recite nor do the other cited references disclose or suggest a toner comprising the external additive recited in instant claim 29.

Claims 1 and 29 are allowable over the prior art of record for the reasons discussed above and in the office action mailed on Mar. 31, 2006, paragraph 3, which are incorporated herein by reference.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLD

Sep. 23, 2006

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